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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/585,222
Filing Date: June 01, 2000
Appellant(s): MASSEY, ROGER

Scott A. Daniels
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 1, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The reference used in the rejection is Matousek '516, not Matousek '895. In the Non-Final Action mailed on 11-26-03, it is clearly stated that the '895 reference is pertinent but not relied upon for the rejection of the claims.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,026,516	MATOUSEK	5-1977
5,944,055	DICKY	8-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 7-9-04.

Claim 6 and 8 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 7-9-04.

(11) Response to Argument

The court in PPG Industries, Inc. v. Guardian Industries Corp. stated that in order "[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."[1] However, "a difference, which consists of a mere omission, or something which a skillful mechanic could supply, is not fatal to anticipation."[2]

The Appellant argues that the barstock valve of Matousek '516 (hereinafter '516) does not read on the apparatus claims of 1, 2, 5, and 7 (please reference the issues section before continuing on page 2 of this examiner's answer). However, the reference would clearly teach to an artisan skilled in the art to make the claimed apparatus.

A careful reading of claim 1 only requires that the barstock from which the valve is made have a "substantially uniform cross-section defining the outer walls[.]" The first issue is what does "substantially uniform cross-section" require. It is a well-known rule that claims are to be given their broadest interpretation. As read by the examiner, the inclusion of the term 'substantial' allows for variation from a uniform cross-section. It is the examiner's contention that barstock of '516 is at the very least substantially uniform. The Appellants arguments reinforce this interpretation. The Appellant argues that the valve of '516 requires extensive milling to acquire the desired shape. This extensive milling is required because the shape of the valve is not the same shape as that of the finished valve. The argument is predicated on an artisan taking a simple piece of barstock and machining it down to the desired shape.

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[1] PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996).
[2] Ranco, Inc., v. Gwynn, 128 F.2d 437, 443 (6th Cir. 1942). Citing Ideal Stopper Co. v. Crown Cork & Seal Co., 131 F. 244 (4d Cir. 1904).

Also when the term is read as a whole, all that is required is that the outer walls of the barstock have a substantially uniform cross-section. Take the inlet and outlet walls of '516 reference before they are milled, and for arguments sake just picture the shape of the barstock is just a squared off version of the valve, the transverse cross-section of those inlet and outlet walls is uniform. As read by the examiner all that the claim requires is one take the barstock, cut the barstock to the desired width (please look to Parker US Patent # 2,309,666 for an example), from the side wall make a parallel cut to the sidewall (transverse cut), and rotate 90 degrees. At this point one has a uniform cross-section defining the outer walls of the barstock. In another words, cut the valve in half as in figure 2 of '516 before drilling the valve stem port and the limitation has been met. It was never claimed that the transverse cross-section must be uniform in reference to every outer wall. This is the interpretation of the claim by the examiner and is easily met by '516 (as it would by any barstock valve).

If claim 7 is any indication as to the meaning of the Appellant, it states that the "substantially uniform transverse cross-section *circumscribed* about the longitudinal axis[.]" This equates to slice perpendicular to the longitudinal axis. Any cross-section taken along the '516 longitudinal axis is uniform (figure 2).

The terminology in question "substantially uniform" was added in the amendment mailed on 5-21-04. As stated in the cited final rejection after said amendment, the interpretation as advocated by the Appellant is approaching new matter. The examiner's interpretation, as discussed *supra*, is supported by the specification. However any other interpretation would be new matter. It appears that the Appellant is trying to argue that the barstock must be box like shape. The Appellant admits (page 18) that the only possible support that the barstock being a box like shape is found in the drawings. However all the drawings disclose is a finished valve. In no way is there support in the disclosure that the barstock must be rectangular. There is no drawing of the preselected barstock. As stated in *Vas-Cath*:

> This court in *Wilder* (and the CCPA before it) clearly recognized, and we hereby reaffirm, that 35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"[, enablement]; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention.*[3] (Emphasis added by the author with underlining)

It is not sufficiently clear that the preselected barstock of the instant invention must be rectangular, only that the final product be rectangular. If the board holds that Appellant's interpretation of the claim is proper, the term is then new matter. The Appellant was warned of this in the cited Final rejection.

For the record, all materials used in manufacturing are preselected.

Another source of contention is the location of the of the flow port that is located on the outlet and inlet ends. While the term "a through machined main flow port located eccentrically on the inlet and outlet ends" could be read to mean that the flow path be eccentrically located in respect

[3] Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-1564 (Fed. Cir. 1991).

to said ends; however, it truly reads as a whole that the flow port of the valve is eccentrically located in reference to the valve as a whole and is located on the inlet and outlet ends *of the barstock*. The claim must be given its broadest interpretation. The latter interpretation is given weight by the next term in the claim, "wherein said main flow port increases the available barstock thickness at one outer wall location and decreases the barstock thickness in the opposite wall." As discussed *supra*, the walls are not necessarily the inlet and outlet ends. The walls include the so-called chimney like chamber prior to the milling. In any case, the ends are only that of the barstock, as discussed below, the '516 flow path is eccentrically located on the ends of the barstock.

Even if the flow port must be eccentrically located on the specific ends. The ends are not defined in such a way to overcome '516. By looking at the '516 figure 2, it is clear that the flow port is eccentrically located through the ends and defined by the valve inlet 12. The ends are defined prior to the intensive machining that is required to make the valve of '516. As discussed below, the barstock is a polygonal shape, the most basic of which is rectangular, and the flow ports are eccentrically bored on those ends.

If the Board does in fact hold that the preselected barstock must be rectangular, it is still taught by '516. As admitted by the Appellant, at the bottom of page 5,.the machining down of the '516 takes a lot of effort. The reason being is that when an artisan reads the specific teaching of '516 (col. 2, lines 58-63) they will select a piece of barstock readily available and make the valve shown. While the reference is not explicit in that the barstock be rectangular, this shape is typically available as indicated by the Appellant's specification on page 1, lines 13-15. In fact it is what the Appellant defines as the industry standard for bar stock as being round or polygon shaped. It only makes sense because the Appellant is arguing that this is the corner stone of the instant invention, the economy of making a valve out of materials so readily available. The available barstock that is taught by '516 includes a rectangular piece of barstock. Remember, "a difference, which consists of a mere omission, or something which a skillful mechanic could supply, is not fatal to anticipation."[4] Here mechanics would use the tools and materials readily available to them and would follow the instructions as understood by them. Barstock means a round or a polygonal (least complex of which is rectangular)[5] shaped piece of metal. It is helpful to look at the figures of '516 and draw a square around the valve. The Appellant's argument is that '516 requires much milling to acquire the desired shape and that the valve of the instant invention does not require the milling. The basis of this argument concedes that the barstock taught by '516 is a bulky squared of piece of barstock. The contention that the barstock used is a more complex shape than what is considered typical bar stock is in fact reading elements into the reference. At best the appellants argument is invoking the doctrine of unexpected results; however, this assertion requires proof not provided here.

[4] Ranco, Inc., v. Gwynn, 128 F.2d 437, 443 (6th Cir. 1942). Citing Ideal Stopper Co. v. Crown Cork & Seal Co., 131 F. 244 (4d Cir. 1904).
[5] Basic geometry.

As to making a valve with multiple ports, '516 specifically states in col. 3, lines 4-7, that the valve can be made with multiple flow outlets. Dicky is used to teach a 3-port valve and that is all. The combination is clearly obvious in view of '516.

As to the method of making, it is an obvious variant of the claimed structure. '516 states that it is made of barstock. The flow port is eccentrically bored in comparison to the center line of the barstock. The valve stem port is bored perpendicular to the flow port. Then placing a selected valve stem in the stem bore. The claimed method of manufacture of this valve is obvious, if not anticipated, by '516.

Given that the claims do not employ the term 'consist', the claims are not limited to the stated limitations. All that is required by claim 1 is a piece of barstock with a hole eccentrically bored through two of its faces. While the valve of '516 requires more processing, it nonetheless meets the limitations.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David Austin Bonderer

January 10, 2005

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